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09/964,147	9/26/2001	Richard Davidson	2001P10389US

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REMARKS

Claims 1-24 are pending in the application. Reconsideration of the application is hereby requested in view of the following remarks.

35 U.S.C. §103(a) Rejections

In the outstanding Office Action, the Examiner rejected claims 1-3, 12, 14, 16 and 24 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,033,076 to Jones et al. ("Jones") in view of U.S. Patent No. 6,496,569 to Pelletier et al. ("Pelletier"). Claims 4-6, 8-11, 13, 15, 17-18, 20 and 22-23 also stand rejected under 35 U.S.C. 103(a) as being unpatentable over Jones in view of U.S. Patent Publication No.2002/0012426 to Gupton ("Gupton"). Claim 21 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Jones in view of Pelletier further in view of U.S. Patent No. 5,872, 840 to Wu ("Wu"). Claims 7 and 19 were rejected under 35 U.S.C. 103(a) as being unpatentable over Jones in view Gupton further in view of U.S. Patent No. 5, 872840 to Wu ("Wu"). Applicants respectfully traverse these rejections.

In order to reject a claim under 35 U.S.C. §103(a), the MPEP mandates that three basic criteria must be met to provide a prima facie case of obviousness:

> First, there must be some suggestion or motivation, either in the reference themselves or in knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claimed limitations.

Applicants submit that the Jones and Pelletier references, either singly or when combined, fail to disclose or suggest all the claimed features of claims 1-3, 12, 14, 16 and 24. Further, Applicants submit that the Jones and Gupton references, either singly or when combined, fail to disclose or suggest all the claimed features of claims 4-6, 8-11, 13, 15, 17-18, 20 and 22-23. Hence, the Examiner has not demonstrated a prima facie case of obviousness of these claims or dependent claims 7, 19 and 21.

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Traversal of Rejected Claims 1-3, 12, 14, 16 and 24
(Jones in view of Pelletier)

In regards to claims 1-3 and 12, each of these claims recites, in part, with variations:

(i) determining whether the called party has a caller ID feature; and

(ii) completing the call if such call is from a public number and the called party has the caller-ID feature.

For example, representative claim 1 includes, in part, "determining whether the called party has a caller ID feature" and "the call is from a public number" and, based on the affirmative result of the determination, completing the call. Applicants submit that Jones fails to disclose or suggest this determination.

In contrast, Jones is directed to a call screening service whereby called customers receive only calls from calling customers who are willing to have their telephone number identified (col. 2, ll.18-26). When a calling customer makes a call to a called customer and the called customer has a class of service indicating that they have a screening service, the calling customer receives an announcement indicating the privacy status of the called customer. The calling customer may respond to the announcement by dialing a digit to indicate an agreement to override the caller's privacy. The class of service does not indicate caller-ID.

In another aspect that clearly distinguishes the inventions of claims 1-3 and 12 over Jones , Jones checks to see if the call is private and, if not (i.e., if public), completes the call, i.e., without any screening as shown by steps 203, 205 in Figure 2 of Jones. However, the inventions of claims 1-3 and 12 checks to see if the call is public and affirmatively checks whether the called party has caller-ID in order to decide whether to complete the call without screening. Therefore, Jones does not disclose or suggest all the features of claims 1-3 and 12.

The Examiner cites several passages (at page 2 and 3 of the Office Action) in an attempt to support his assertion that Jones checks for caller-ID. However, a close scrutiny of these passages and the entire Jones reference reveals that Jones does not disclose this feature

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and, thus, does not show determining whether the called party has caller-ID and completing the call if such call is from a public number and the called party has the caller-ID feature. Moreover, since a check is not made for caller-ID, Jones does not therefore show the combination of determining whether the called party has caller-ID <u>and</u> determining if the call is a public number in order to complete the call based on an affirmative combined result.

Specifically, the Abstract of Jones, which was cited by the Examiner, does not disclose checking for caller-ID. Rather, the Abstract simply discloses that a customer may have a class of service indicating that the customer has the <u>screening service</u>. This is not determining whether the called party has caller-ID.

Further, the passage cited by the Examiner at col. 2, lines 44-50, also <u>does not</u> disclose determining whether the called party has caller ID. Rather, this passage simply states, in part, that

> ...the called customer is enabled to receive calls from callers willing to identify themselves and the privacy of the calling customer is protected since the calling party is identified only when the calling party specifically grants permission for such identification.

Nowhere in this passage is there a check to determine whether the called party has caller-ID as a basis for deciding whether to perform screening. It simply states the called party is enabled (i.e., via the screening class of service) to receive calls from callers willing to identify themselves. But no check is ever made to determine if the called party indeed has caller-ID. The screening service is not the same as caller-ID. The screening feature of Jones is processed regardless of whether the called party actually has caller-ID or not (assuming a private call). That is, for example, Jones does not predicate any screening processing on whether the called party actually has caller-ID and is quite oblivious to ever checking if the called party has caller-ID. The invention of claim 1-3 and 12 on the other hand, checks to see if the call is a public call <u>and</u> the called party has caller-ID in order to complete the call.

Similarly, at the cited passage of col. 3, lines 2-19, Jones again fails to disclose determining whether the called party has caller-ID in order to decide whether to perform

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screening processing. Rather, this passage only shows that the called party's class of service is consulted to decide to determine whether the called party has the screening class of service. There is no check to determine whether the called party has caller-ID.

In Jones, the screening function is always performed if the called party has the class of service and the call is a private call (Fig 2 and related description at col. 4, line 22 to col. 5, line 26) Whereas, in contrast, in the invention of claims 1-3 and 12 a check is made to determine whether the called party indeed has caller-ID and a check is made whether the call is public in order to complete the call, without an announcement. In Jones, a check is made to see if the called party has the screening class of service (that indicates whether the announcements are to be played or not, for private calls, only) (Fig 2 and related description at col. 4, line 22 to col. 5, line 26). Jones is indifferent as to whether the called party actually has caller-ID or not, and as a result never provides any "screening" processing for a public call. The invention of claims 1-3 and 12 on the other hand, makes a specific check to determine if the called party has a caller-ID, and provides for the possibility that announcement processing may occur when a call is public and the called party has no caller-ID. Jones is incapable of performing this function which is confirmed by Figure 2 of Jones where it shows that a check is made for a private call, and only when the call is private (never public), does screening occur.

As to the cited passage at col. 4, lines 12-21, this passage also does not show checking for caller-ID. Rather, this passage simply states that memory blocks are a part of the processor for storing calling party directory numbers and privacy data. Similarly, the cited passage at col. 4, lines 35-38 simply states that the system checks the class of service for the screening feature, but does not disclose checking for caller-ID.

As to the cited passage at col. 4, lines 63-68, this passage simply shows checking if the caller has requested privacy (i.e., a private call) and, if not, the call is processed conventionally. And, if the call is private, then a check is made to see if the called party has the screening class of service. But, this passage does not show checking for caller-ID. Furthermore, none of the cited column 4 passages show the combinational requirement of checking for caller-ID and checking to see if the call is from a public number, as required by claims 1-3 and 12 for "completing the call" without an announcement.

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The Examiner relies upon the Pelletier reference, citing col. 5, lines 32-49 and col. 8, line 32 – col. 9, line 57, to allegedly supply the missing features of Jones including, a determination whether the called party has caller-ID and basing a decision on this determination and whether the call is from a public number. Applicants respectfully submit that the Examiner has misinterpreted these cited Pelletier passages and Pelletier does not in fact supply the missing features of Jones.

Pelletier is directed to a service provided by a phone system to which a party may subscribe (col. 5, lines 35-44). The service of Pelletier, when subscribed to by a called subscriber, makes a determination whether standard caller identification from the calling party is available (co. 5, line 32-39). If standard caller identification information is not available, audible caller information is gathered from the caller by the phone system to be presented audibly to the called party, depending on level of service selected by the called party (col. 5, line 50 – col. 6, line 3) If the calling party does not provide such information, the call is blocked (col. 6, lines 3-6). Pelletier does not, in fact, ever disclose determining whether the called party has caller-ID or not, and further, does not disclose basing any action on whether the call is a public call and the called party has caller-ID.

A careful analysis of the passages relied upon by the Examiner, i.e., col. 5, lines 32-49 and col. 8, line 32 – col. 9, line 57 (along with the rest of Pelletier), does not support the Examiner's interpretation (page 4 of the Office Action, and elsewhere). As disclosed, in part, at the cited passage at col. 5, lines 32-49, "a trigger generates a query that is sent to the SCP (step 320)" (at lines 35-36). The query requests the calling party standard caller-ID information (at lines 39-40). Next, the SCP 400 receives the query and determines whether or not the called party at called telephone station 222 subscribes to the "present service" (lines 43-45). However, Applicants respectfully submit that the Examiner mistakenly interprets that the phrase "present service" as referring to "caller-ID." The phrase "present service" does not refer to "caller ID" as the Examiner maintains, but, is instead referring to the "service" provided by Pelletier, i.e., the audible calling party identification service (see context provided, for example, col. 2, lines 24-49, and also col. 3, lines 9-35 in reference to the method of Fig. 2)

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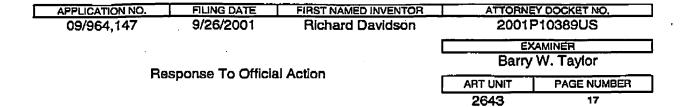| ART UNIT	PAGE NUMBER
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In view of Pelletier at col. 2, lines 24-49, col. 3, lines 9-35 In reference to the method of Fig 2, and also throughout Pelletier, it can be readily and appropriately ascertained that in the cited passage at col. 5, lines 32-49, the phrase "present service", means the audible calling party identification service provided by Pelletier, and not caller-ID. The Applicants' interpretation is definitively confirmed by other passages in col. 5 and col. 6.

At col. 5, line 45-49, it states:

> In response to a determination that the called party subscribes to
> the *present service*, SCP 240 analyzes information included with the
> query to determine whether standard *Caller ID Information* can be
> provided to called station 222 (step 330). (emphasis added)

Applicants submit that the "determination that the called party subscribes to the present service" in this passage refers to discovering if the called party subscribes to the Pelletier service (i.e., the audible calling information service) and, if so, an analysis is done to determine if calling party information (i.e., caller-ID information of the calling party) is available (e.g., provided by the phone system from the calling party's originating end) so that the information can be provided to the called station. Applicants' interpretation is further confirmed by the detailed steps of Figs. 6 and 7 of Pelletier described by col. 6, lines 7-65 (which are detailed expansions of cited step 330 of Fig. 5, per col. 6, line 8). The passages at col. 6, line 7-65 clearly show that the determining steps concern checking if calling party caller-ID information is available and, if not, then proceeding with the "audible service" provided by Pelletier, as described in reference to Figs 6 and 7. Nowhere in this more detailed explanation of step 330 (Figs. 6 and 7 of Pelletier described by col. 6, lines 7-65), as relied upon by the Examiner in col. 5, lines 44-49, is there any disclosure or suggestion that a determination is being made whether the called party has caller-ID. Therefore, the "present service," e.g., at col. 5, lines 46-47, refers to the audible caller identification service provided by Pelletier's disclosure and not caller-ID. The Applicant's interpretation is solidly confirmed at col. 7, lines 48-56, where it states:

> In a further alternative embodiment, the present system and method
> can be configured to work in conjunction with standard caller

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identification services. After a trigger is sent from the SSP 220 (step 320, Fig. 5), the SCP 240 can determine whether the called party at the called telephone station 222 has <u>subscribed to the present service. If the called party has not subscribed to the present service, the call can be handled in accordance with standard Caller ID procedures as know to those skilled in the art.</u> (emphasis added)

As this passage clearly shows, the "present service" is referring to the audible calling party identification service provided by Pelletier because Pelletier <u>is specifically contrasting his present service with standard Caller ID procedures know to those skilled in the art</u>. Therefore, the "present service" cannot be referring to caller-ID as asserted by the Examiner on page 4 and elsewhere of the Office Action. As such, Pelletier does not disclose "determining whether the called party has a caller ID feature," which is required by independent claims 1-3, and similarly by claim 12. For at least this reason, Applicants submit that neither Jones nor Pelletier, nor any other reference of record, either singly or in combination, discloses or suggests all the limiations of claims 1-3 and 12 and that the §103(a) rejections of claims 1-3 and 12, and those claims depending therefrom, should now be withdrawn. Since none of the other prior art of record, whether taken alone or in combination, discloses or suggests, all the limitations of claims 1-3 and 12, Applicants respectfully submit that these claims are now in condition for allowance.

<u>Traversal of Rejected Claims 4-6, 8-11, 13, 15, 17-18, 20 and 22-23</u>
(Jones in view of Gupton)

This rejection is traversed for the following reasons. First, the Examiner states on page 10 of the Office Action that Jones discloses "if the called party has a caller ID feature" and cites several passages in an attempt to support this assertion. Applicants have already showed above that Jones does not in fact ever disclose or suggest "determining whether the called party has a caller ID feature" and completing the call if such call is from a public number and the called party has the caller-ID feature. Further, neither Gupton, nor any other reference of record, discloses or suggests this limitation either. Therefore, for at least this reason, Applicants

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submit that the 103(a) rejections of independent claims 4, 5, 8, 9, 11, 13 and the claims depending therefrom, should be withdrawn.

Furthermore, the Examiner is relying upon Gupton to provide "screening calls to jurisdictions" (page 11 of the Office Action). Gupton is directed to a system and method for rejecting telephone calls from soliciting and telemarketing organizations by querying a solicitor database to determine whether the calling party number is associated with a soliciting or telemarketing organization, and querying a non-solicitation database to determine whether the called party has chosen to reject calls from a soliciting and telemarketing organizations (Figs. 2, 5 and Summary). When the called party has chosen to reject calls from soliciting and telemarketing organizations, calls from such organizations are blocked if they are found in the solicitor database (Fig. 2, 5 and Summary).

However, Gupton does not disclose several features recited by the independent claims 4, 5, 8, 9, 11, 13. For example, independent claim 5 recites, in part:

> determining if a jurisdiction of a called party requires solicitor's
> telephone calls to be identifiable by the called party...

also, independent claims 8 and 9 recite, in part:

> determining whether the jurisdiction where such call is made to
> may be made from only a public telephone number...

and, claims 11 and 13 recite, in part:

> determining whether a call to such jurisdiction is from a public
> telephone number or from a private telephone number...

Applicants submit that neither Gupton, nor any other reference of record, discloses or suggests these limitations. Rather, Gupton at the paragraphs cited by the Examiner [0024 -0028] simply discloses that municipalities may require licensing of soliciting and telemarketing organizations. Applicants suggest that many types of businesses require licenses for many different types of

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activities as is commonly known. The penalty is associated with "not obtaining a license." [0024] Once a license is obtained, a list of licensed organizations is then made available with appropriate data. The municipalities of Gupton do not have any "jurisdiction" themselves over telephone calls. The Examiner appears to be associating municipalities that require licensing of telemarketing organizations to jurisdictions that govern telephone calls. This is simply incorrect and is not disclosed in Gupton. Gupton simply discloses that licensed (the license being required by municipalities) telemarketing organizations have their information made available and that solicitor databases may be developed independently based on this information. Subscribers who then may voluntarily set up a non-solicitation database entries may then have calls blocked for those organizations that might be listed in the solicitor's database [0025]. The municipalities of Gupton are not "jurisdictions" of the claimed inventions and do not in any way affect determination of call control and, in fact, have nothing to do directly with phone calls at all. The municipalities of Gupton are simply issuing business-type licenses requiring release of organizational information. The license information may then be used to independently build databases. But, the municipalities in Gupton have no correspondence to jurisdictions of the claimed inventions. In effect, it is the subscribers of Gupton that decide what calls they receive and do not receive, not jurisdictions.

Gupton's "municipality requirements" [0024-0028; 0034] are directed to business-type licenses for making organization data generally available, which has nothing to do with the determination step as required by claim 5 which recites, in part: "determining if a jurisdiction of a called party requires solicitor's telephone calls to be identifiable by the called party"; or, as required by claims 8 and 9 which recite, in part: "determining whether the jurisdiction where such call is made to may be made from only a public telephone number"; or, as required by claims 11 and 13, which recite, in part: "determining whether a call to such jurisdiction is from a public telephone number or from a private telephone number." Applicants submit that there is no "jurisdiction" disclosed or suggested in Gupton (nor any other reference of record) as required by independent claims 4, 5, 8, 9, 11, 13, and, as such, Gupton does not provide the missing limitations of Jones, either singly or in combination. Therefore, Applicants respectfully submit that the 103(a) rejections of independent claims 4, 5, 8, 9, 11, 13, and all claims

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depending therefrom, should now be withdrawn, and that these claims are now in condition for allowance.

Moreover, Applicants submit many of the dependent claims recite distinctly patentable subject matter. For example, claims 17 and 18 recite, in part, "wherein the determining jurisdiction step is determined on a per call basis." Applicants submit that neither Gupton, nor any other reference of record, discloses or suggests this limitation. Jurisdiction determination on a per call basis is simply not present in these references.

Traversal of Rejected Claim 21 (Jones in view of Pelletier in view of Wu)

and Rejected Claim 7 and 19 (Jones in view of Gupton in view of Wu)

Applicants submit that each of these rejected dependent claims depend from an allowable independent claim and for at least this reason are also allowable.

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Conclusion

In view of the foregoing remarks, Applicants submit that all of the claims are patentably distinct from the prior art of record and are in condition for allowance. The Examiner is invited to contact the undersigned at the telephone number listed below, if needed. Applicants hereby make a written petition for extension of time, if needed. Please charge any deficiencies and credit any overpayment of fees to Deposit Account No. 19-2179.

Respectfully submitted,

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